

REMARKS**INTRODUCTION**

In accordance with the foregoing, claims 6 and 10-12 have been amended and claims 9 and 13 have been cancelled, without prejudice or disclaimer. No new matter has been submitted.

Claims 1-3 and 5 have been allowed.

Claims 1-3, 5, 6, and 10-12 are pending and under consideration.

REJECTION UNDER 35 USC 112

Claim 11 stands rejected under 35 USC § 112 for including antecedent informalities. Claim 11 has been amended to remove this informality.

Therefore, withdrawal of this rejection is respectfully requested.

REJECTIONS UNDER 35 USC 102

Claims 6 and 11 stand rejected under 35 USC § 102(e) as being anticipated by Lee, U.S. Patent No. 6,219,037. This rejection is respectfully traversed.

As noted above, independent claims 6 and 11 have been amended to include features from dependent claims 9 and 13, respectively.

Regarding independent claim 6, it is respectfully submitted that Lee at least fails to disclose the claimed wireless mouse including both the claimed connector terminal and charging terminals. The Office Action (in later rejecting claim 9) relies on Tanmachi et al., Japanese Patent Publication 410301708, to disclose the claimed connector terminal. However, as Lee would not need both charging terminals and the claimed connector terminal, it is respectfully submitted that it would not have been obvious to modify Lee to incorporate the terminal of Tanmachi et al.

In addition, in rejecting canceled claim 9, the Office Action took Official Notice of USB being well known. In addition to requesting the a evidencing reference, Applicant's also note that regardless of how well known a feature is, the modification of the underlying reference must still meet a prima facie obviousness standard, i.e., evidenced motivation must still be supplied. The Office Action merely recites that the feature is well known and concludes that it would have been

obvious to modify the underlying reference based on unsupported motivation, i.e., the Examiner's beliefs, noting that a prima facie obviousness case must be based on evidenced motivation outside of the general beliefs of the Examiner.

It is well settled that "the Board [and Examiners] cannot simply reach conclusions based on [their] own understanding of experience[s] - or on [their] assessment of what would be basic knowledge or common sense. Rather the Board [and Examiners] must point to some concrete evidence in the record in support of these findings." In re Zurko, 258 F. 3d 1379, 1386, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001). See also In re Lee, 277 F. 3d 1338, 1344-45, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002), in which the court required evidence for the determination of unpatentability by clarifying that the principles of "**common knowledge**" and "**common sense**" may only be applied to the analysis of evidence, rather than be a substitute for evidence. The court has also recently expanded their reasoning on this topic in In re Thrift, 298 F. 3d 1357, 1363, 63 USPQ2d 2002, 2008 (Fed. Cir. 2002).

Thus, any prima facie obviousness case must include evidenced motivation.

Regarding independent claim 11, the Office Action relies on Lee to disclose all the previous features of independent claim 11 and relies upon Yamaguchi et al., Japanese Patent Publication No. 411110130, to disclose the features of claim 13.

However, it is respectfully submitted that neither Lee nor Yamaguchi et al., alone or in combination, disclose or suggest all the feature of independent claim 11, as amended. Yamaguchi et al. fails to disclose at least both the claimed connector terminal and charging terminals, and Lee fails to disclose at least the claimed charging terminals. As noted above, it is respectfully submitted that it would not have been obvious to modify either Lee or Yamaguchi et al. to disclose all the claimed features of the presently claimed invention.

Lastly, it is noted that the Office Action is relying on abstracts of the foreign references to support the outstanding rejections. It is respectfully submitted that such reliance should not be the sole basis for a rejection of the claims or support for modification of the same.

Further, regarding the use of foreign language abstracts, the court in Ex parte Gavin noted: "[i]n this appeal, the examiner relied upon abstracts of two published Japanese patent applications without referring to translations of the underlying applications. An abstract and the underlying document of which it is a summary are distinct documents. In a rejection, an abstract stands on its own—it does not incorporate by reference any disclosure of the underlying

document. Abstracts are often not written by the author of the underlying document, and may be erroneous or misleading—in virtually all cases, they are incomplete." Ex parte Gavin, 62 USPQ2d 1680, 1683 (BPAI 2001).

"Generally an abstract does not provide enough information to permit an objective evaluation of the validity of what it describes. Thus, an abstract is even less reliable a basis to extrapolate the alleged teachings of the underlying document to different circumstances. Abstracts function to alert a reader to disclosures of possible interest. They are little more reliable than headlines or brief newspaper articles. Citation of an abstract without citation and reliance on the underlying scientific document itself is generally inappropriate where both the abstract and the underlying document are prior art. It is our opinion that a proper examination under 37 CFR §1.104 should be based on the underlying documents and translations, where needed. Accordingly, the preferred practice is for the examiner to cite and rely on the underlying document." Id. at 1684.

Finally, "a prior publication or patent description will be considered as anticipatory when its disclosure is at once specific and enabling with regard to the particular subject matter at issue...However, such disclosure may yet be held to not legally anticipate the claimed subject matter if it is found not to be sufficiently enabling, in other words, if it does not place the subject matter of the claims within the possession of the public." In re Wilder, 166 USPQ 545, 548 (CCPA 1970).

Thus, the aforementioned reliance on the abstracts of the cited Japanese references is insufficient to provide the required disclosure or evidentiary motivational support required for a prima facie anticipatory or obviousness case.

Therefore, for at least the above, it is respectfully requested that this rejection of claims 6 and 11 be withdrawn and claims 6 and 11 be allowed. In addition, for at least the above, it is respectfully requested that claims depending from independent claims 6 and 11 also be allowed.

REJECTIONS UNDER 35 USC 103

Claims 7 and 8 stand rejected under 35 USC § 103(a) as being obvious over Lee, U.S. Patent No. 6,219,037, in view of Yamaguchi et al. This rejection is respectfully traversed.

Similar to above, it is respectfully submitted that claims 7 and 8 are allowable, at least for their dependence from independent claim 6, and for the Office Action's failing to provide a prima facie obviousness case, e.g., the cited motivation would not appear to be supported by the record and the underlying support for the addition of the solar battery cell to Lee would only appear to be based on an English language abstract of Yamaguchi et al. (and a drawing) without evidencing the corresponding motivation for the proffered rejection. Therefore, this rejection fails to set forth a prima facie obviousness case.

In addition, it is noted that claim 8 and independent claim 11 both reference the solar battery cell capturing light "emitted from the light emitter" (claim 8) and independent claim 11 further indicates that light is "captured from a working surface." It is respectfully submitted that none of the cited references disclose at least this feature.

Claim 10 stands rejected under 35 USC § 103(a) as being obvious over Tanmachi et al., Japanese Patent Publication 410301708. This rejection is respectfully traversed.

At least in view of the above, and for being dependent from claim 6, it is respectfully submitted that dependent claim 10 is also in proper condition for allowance.

Claim 12 stands rejected under 35 USC § 103 (a) as being obvious over Lee. This rejection is respectfully traversed.

At least in view of the above, and as claim 12 depends from independent claim 11, it is respectfully submitted that dependent claim 12 is also in proper condition for allowance.

CONCLUSION

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

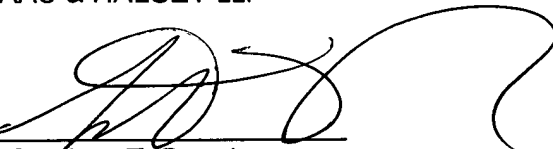
Respectfully submitted,

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6/28/04

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